

The opinion in support of the decision being entered today
was not written for publication and is not binding precedent of the Board.

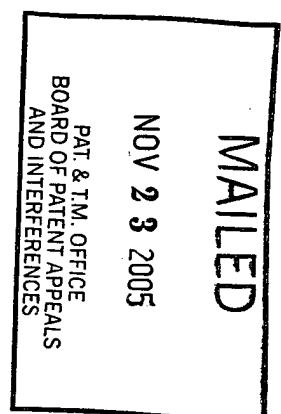
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLORY F. CEMAN, PAULETTE M. ROSCH,
JAN E. CARR, DONALD G. FOX, LISA R. WHITE,
AND TARA E. ANDREWS

Appeal No. 2006-0062
Application No. 10/003,077¹

ON BRIEF



Before KIMLIN, TIERNEY and FRANKLIN, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 25-52. We affirm the examiner's rejection.

The Claimed Subject Mater

Appellants' claims are generally directed to a feminine care product having a text message. In particular, appellants' state the claimed feminine care product is "an article of

¹Application for patent filed on November 2, 2001.

manufacture directed generally to the well-being, health and fitness of women during menstruation, which includes both physical and emotional factors.” (Appeal Brief, p. 2).

Findings of Fact

1. The real party in interest of Ceman et al., U.S. Application 10/003,077 (“‘077”) is Kimberly-Clark Worldwide, Inc. (Appellants’ Brief, p. 1).
2. The ‘077 application was filed on November 2, 2001.

I. The Claims

3. Claims 25-52 are currently pending in the ‘077 application, all of which are on appeal.
4. Appellants’ take the position that its claims stand or fall together in two independently patentable groups: 1) claims 25-37, and 2) claims 38-52. (*Id.* at p. 5).
5. The claims of Group I generally requires feminine care product having a text message, wherein the text motivates, entertains, educates, or inspires the user, but the text is not related to instructing in the use of the product or designate a source of the product. Claim 25 is representative and reads as follows:

A feminine care product comprising:

a body having a peripheral edge, a first side, and a second side opposite said first side; an adhesive coating applied to said first side of the body permitting a user to attach said

body to a preselected surface; and

a covering removably attached to the adhesive coating to prevent attachment of the body before the user removes the covering from the adhesive coating, said covering having a size and shape selected for covering at least a portion of the adhesive coating when attached to the adhesive coating, a release side for contacting the adhesive coating when the covering is attached to the coating, and a message side opposite said release side;

wherein said message side of the covering includes text directed to communicating a message to the user related to at least one of motivating the user, entertaining the user, educating the user, and inspiring the user, wherein said text is unrelated to instructing use of the feminine care product or designating a source of the feminine care product.

(Appellants' Brief, Appendix, p. 14).

6. The claims of Group II are generally directed to a feminine care product for addressing physical and emotional needs of a women during menstruation by placing a text message that mitigates a women's emotional lows. Claim 38 is representative and reads as follows:

A feminine care product for addressing both the physical and emotional needs of a women during menstruation comprising:

an absorbent body for adsorbing body fluids discharged during menstruation, the absorbent body having a peripheral edge, a first side, and a second side opposite said first side;

an adhesive coating applied to said first side of the body permitting a user to attach said body to a preselected surface; and

a covering removably attached to the adhesive coating to prevent attachment of the body before the user removes the covering from the adhesive coating, said covering having a size and shape selected for covering at least a portion of the adhesive coating when attached to the adhesive coating, a release side for contacting the adhesive coating when the covering is attached to the coating, and a message side opposite said release side;

wherein said message side of the covering includes text communicating a message to the user for mitigating the emotional lows some women experience during menstruation.

(*Id.*)

II. Ceman's '077 Specification

7. Ceman's '077 specification states that the present invention relates to "a method of establishing and nurturing a business relationship between an absorbent article seller and a consumer of the articles." ('077, p. 1, lines 3-6).

8. According to the '077 specification, an absorbent feminine product "[i]ncluding messages intended to motivate, entertain, educate and/or inspire could be beneficial to women." ('077, p. 1, lines 28-30).

9. The '077 specification states that a conventional absorbent article depicted in Figures 1 and 2 is represented in its entirety by the reference numeral 20. ('077, p. 3, lines 27-29).

10. The '077 specification states that, except for indicia applied to a covering:

All other aspects of the napkin 20 are conventional and well known by those skilled in the art. Thus, the materials used in making the napkin 20 describe above, the detailed construction of the napkin, and the method of manufacturing the napkin are well known and will not be described in further detail. One such conventional napkin 20 is described in [Beal et al.] U.S. Pat. No. 5,429,630, issued July 4, 1995.

('077, p. 5, lines 11-17).

11. The '077 specification teaches that its absorbent article 20 depicted in Figures 1 and 2 has:

- i) an absorbent body 24 having a peripheral edge 26, a first side 28 and a second side 30 opposite the first side. ('077, p. 4, lines 1-4).

- ii) an adhesive coating 40 applied to a first side 28 of the body 24, the coating permitting a user to attach the body to a preselected surface. ('077, p. 4, lines 15-20).
- iii) a covering or label 42 removably attached to the adhesive coating 40 to prevent attachment of the body 24 before the user removes the covering from the adhesive coating. ('077, p. 4, lines 24-27).

12. As mentioned above, the covering on the absorbent article contains a message side having indicia and/or text. The '077 specification describes the message as follows:

The message is related to at least one of motivating the user, entertaining the user, educating the user, and inspiring the user. Further, the message is intended to establish and/or nurture a business relationship between a seller of the absorbent articles and a consumer. For example, the indicia 48 may communicate an inspirational or motivational message such as "Life is a verb, not a noun," or "Live each day to its fullest." Examples of an entertaining message include humorous messages such as "You flow girl." or fortune-cookie-type messages such as "You will mend a rift with an old friend," or trivia-type messages such as "Did you know that black is the most popular underwear color among women?" An example of an educational message includes health related messages such as "Remember to drink eight glasses of water each day to stay healthy," or "Visit your gynecologist annually for good health."

('077, p. 5, lines 20-35).

Prior Art - Beal U.S. Patent No. 5,429,630

13. Beal, U.S. Patent No. 5,429,630 ("Beal '630") issued on July 4, 1995 and is available as 35 U.S.C. §102(b) prior art as against Ceman '077.

14. Ceman's '077 specification identifies the Beal '630 patent as describing the "well known" materials, construction and method of manufacturing a feminine product 20. ('077, p. 5, lines 11-17).

15. Beal '630 describes a feminine product having an absorbent body **16**, an adhesive coating **40** and covering **46**. (See '630, Figures 1 and 2).

16. A review of Beal's '630 patent confirms that, except for the indicia/text on the covering, Beal describes a feminine product having the same absorbent body, adhesive coating and covering described by Ceman '077.

17. Beal '630 states that its pad can contain a plurality of embossed areas. ('630, col. 5, lines 48-49).

18. Beal '630 teaches that the embossed areas can "be in the form of dots, flowers, etc." ('630, col. 5, lines 58-59).

19. Beal does not specifically identify its covering 46 as containing text/indicia.

Prior Art - Cole, U.S. Patent No. 5,147,698

20. Cole, U.S. Patent No. 5,147,698 ("Cole '698") issued on September 15, 1992 and is available as 35 U.S.C. §102(b) prior art as against Ceman '077.

21. Cole describes a pressure sensitive adhesive film article for "treating a wound or attaching a device or article to the skin." (Cole '698, abstract).

22. Cole '698 states that its adhesive may contain a liner or backing suitable for the product. ('698, col. 7, lines 4-8).

23. Cole '698 teaches that the liner or backing may have a "logo, a decorative design, or instructions for the use of the product." ('698, col. 7, lines 8-17).

24. Cole teaches that its carrier and plastic film overlay, *i.e.*, liner or backing, should have an attractive appearance. ('698, col. 7, lines 11-17).

Final Office Action of December 1, 2003

25. The examiner's Final Office Action of December 1, 2003 rejected Ceman '077 claims 25-52 over Beal '630 in view of Cole '698.

26. The Final Office Action generally takes the position that Beal '630 teaches all stated limitations of Ceman claims 25-52, with the exception of the printed indicia, which is taught by Cole '698.

27. The Final Office Action states that:

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Cole's teaching of using printed indicia on the release paper in the invention of Beal to promote the product in that it provides for inspiration to use the product, entertains and motivates the user to use the product, etc.

(Final Office Action, p. 4).

Ceman's Brief on Appeal

28. Ceman's brief takes the position that “[t]he present invention is unique in its function of holistic treatment of conditions of menstruation.” (Appeal Brief, p. 6).

29. Ceman's brief discusses the teachings of Beal '630 as follows:

Beal discloses a feminine care product but does not disclose an adhesive covering containing a message. Accordingly, Beal is not directly pertinent to the distinction that appellants submit make the present invention patentable.

(Appeal Brief, pages 6- 7).

30. Ceman does specifically contest the examiner's position that Beal '630 teaches all structural limitations of Ceman claims 25-52, with the exception of appellants' message text.

31. According to Ceman's brief:

Cole does not teach or suggest a releasable liner having text communicating a message for motivating, entertaining, educating, or inspiring the user, wherein the text is unrelated to instructing use of the product or designating a source product.

(Appeal Brief, p. 7).

32. Ceman's brief argues that Ceman's message text has a new and unobvious functional relationship with Ceman's feminine product as follows:

The message or subject matter of appellants' claimed text has a new and unobvious relationship with the claimed feminine care product. This relationship is new and unobvious because it allows a holistic treatment of women's menstrual periods by the claimed feminine care product that has not been previously achieved. The claimed feminine care product body treats the menstrual condition

by collecting the discharge associated with menstruation. The claimed covering has text with a message that functionally relates to the treatment of menstruation addressed by the feminine care product body. The claimed text treats the emotional condition that is inexorably a part of menstruation. This combination is unique and patentable in its function of holistic treatment of menstruation.

(Appeal Brief, p. 10).

33. Ceman's brief on appeal fails to explain how its claimed message text, which explicitly includes education text, provides a holistic treatment or relates to treating an emotional condition.

Examiner's Answer of August 11, 2004

34. The examiner's answer takes the following position regarding the use of Ceman's claimed message text:

Appellant is again informed here that the logo [of Cole '698] could provide for motivating the user, inspiring the user, or even educating the user. For example, a particular logo promotes the quality and performance of a product and would draw the attention of a user, motivate and inspire to use said product instead of the general or generic products. Similarly, the presence of decorative design on the release liner would not only entertain the user, it will also provide for inspiration and motivation to the user because the decorative design is appealing and attractive to impart positive response from the user.

(Examiner's Answer, p. 5).

35. The examiner's answer considered Ceman's argument regarding the patentable weight of the claimed message text, but determined that the claimed message text lacked a functional relationship with the product. (Examiner's Answer, p. 6).

Opinion

The examiner's answer provides two rejections of Ceman's claims. The first rejection is directed to Ceman '077 claims 25-37 and the second rejection involves Ceman '077 claims 38-52. Both the first and second rejection state that Ceman's claims are unpatentable under 35 U.S.C. § 103(a) over Beal '630 in view of Cole '698. As noted above, the examiner alleges that Beal '630 teaches a feminine product having Ceman's claimed absorbent body, adhesive coating and covering. The examiner states that Beal '630 does not explicitly teach the use of a covering having an indicia printed thereon. The examiner cites Cole '698 as teaching the desirability of covering for an adhesive structure where the outer side of the covering contains indicia such as a logo, decorative design, instruction, etc. The examiner concludes that it would have been obvious to one of ordinary skill in the art to place indicia, such as a logo, on the covering of Beal's feminine product as Cole teaches the use of such indicia for coverings and one of ordinary skill in the art would have understood that such indicia would motivate, educate and inspire the user due to the appealing and attractive designs that could be employed that educate the user as to the higher level of quality of the product as compared to a generic product. (Examiner's Answer, p. 3-5).

Ceman takes the position that the examiner's rejection is incorrect. Generally, Ceman raises two arguments regarding the underlying merits of the examiner's position. Ceman argues that the examiner failed to give the appropriate "patentable weight" to the claimed message text when determining its patentability. (Appeal Brief, p. 8). Ceman also argues that Cole '698 does not provide the needed motivation to arrive at Ceman's claimed invention as Cole '698 does not "teach or suggest a releasable liner having text communicating a message for motivating,

entertaining, educating, or inspiring the user.” (Appeal Brief, p. 7).

Functional Relationship of Claimed Message Text and Product

Ceman argues that the examiner’s position can succinctly be stated as follows: “text it text.” (Appeal Brief, p. 8). Ceman states that this position is inconsistent with established precedent. Specifically, Ceman argues that the law is as follows:

According to 35 U.S.C. §103(a), the subject matter of the claim (including any printed matter) must be viewed “as a whole” in order to determine its patentability. In re Gulack, 703 F.2d 1381, 1385 (Fed Cir. 1983). Thus, in an article of manufacture claim, text can be given “patentable weight” so long as the printed matter has a functional relationship with the article. [Citations omitted].

(Appeal Brief, p. 8).

Ceman argues that its claimed text has a new and unobvious relationship with the claimed feminine product as it allows a holistic treatment of a women’s menstrual period. According to Ceman:

The claimed feminine care product body treats the menstrual condition by collecting the discharge associated with menstruation. The claimed covering has text with a message that functionally relates to the treatment of menstruation addressed by the feminine care product body. The claimed text treats the emotional condition that is inexorably a part of menstruation. This combination is unique and patentable in its function of holistic treatment of menstruation.

(Appeal Brief, p. 10).

Ceman has relied upon the Federal Circuit’s decision in *In re Gulack*. The Federal Circuit in *In re Ngai*² specifically discusses the decision in *Gulack* and addressed *Gulak*’s “proper meaning.”

²367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

Ngai involved an appeal from the Board of Patent Appeals and Interferences (“Board”). The appeal involved a single claim directed to a kit designed to perform a method where the kit contained instructions. The Board affirmed an examiner’s rejection of claim 19 as anticipated as the prior art taught each and every limitation of the claim including the use of instructions. The Board found that the only difference between Ngai’s claimed invention and that of the prior art was in the content of the instructions.

On appeal, Ngai relied upon the decision in *Gulack* and argued that “the addition of new printed matter to a known product makes the product patentable.” 70 USPQ2d at 1863-64. The USPTO opposed Ngai’s interpretation of *Gulack* and argued that “the printed matter must be functionally related to the underlying object.” The Federal Circuit agreed with the USPTO and held that “[t]he PTO has the better argument.” 70 USPQ2d at 1864. According to the Federal Circuit:

Here, addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product. As the *Gulack* court pointed out, “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *Id.* If we were to adopt Ngai’s position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product. This was not envisioned by *Gulack*. Ngai is entitled to patent his invention of a new RNA extraction method, and the claims covering that invention were properly allowed. He is not, however, entitled to patent a known product by simply attaching a set of instructions to that product.

367 F.3d at 1339, 70 USPQ2d at 1864.

As noted above, Ceman argues that its claimed message text is functionally related to the feminine product as the text treats the emotional condition and the product treats the physical condition associated with menstruation. Ceman, however, fails to specifically identify a claim construction that is consistent with a functional relationship.

Functionality of Message Text with Claimed Feminine Product

We give the language of the claims their broadest reasonable interpretation as they would be understood by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Specifically, a claim term should be given its ordinary meaning as it is understood in the art subject to a special, different meaning or definition provided by the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316-1317, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc), *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091, 68 USPQ2d 1516, 1523 (Fed. Cir. 2003); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662-63 (Fed. Cir. 2002).

Ceman '077 claims 25-37, of which claim 25 is representative, requires message that is: directed to communicating a message to the user related to at least one of motivating the user, entertaining the user, educating the user, and inspiring the user, wherein said text is unrelated to instructing use of the feminine care product or designating a source of the feminine care product.

(Appellants' Brief, Appendix, p. 14). Ceman's specification provides specific examples of text that is considered to fall within the scope of its educational, entertaining, inspiring or

motivational goals. Ceman's specification fails to provide specific guidance as to what is not considered educational, entertaining, inspiring or motivational.

The difficulty with construing the message text of Ceman claim 25 is that the claim requires a subjective rather than objective construction of the metes and bounds of the claim. For example, what one woman may consider entertaining another may consider annoying or demeaning. Similarly, we find it difficult to determine the reasonable breadth of what is considered educational. For example, we question whether the mere identification of the product as a "feminine product" could be considered educational in that it educates the user as to the nature of the product.

Given the subject nature of claims 25-37 we are unable to state with certainty a bright line boundary of what is and is not covered by the claimed message text. Yet, we can state with certainty that what is covered by claims 25-37 is not limited to a "holistic treatment." For example, Ceman's exemplified educational message "Visit your gynecologist annually for good health" is not considered a treatment of a women's emotional condition associated with menstruation.³

Ceman claims 38-52, of which claim 38 is representative, require message text on a feminine care product where the text communicates a message to the user for mitigating the emotional lows some women experience during menstruation. Whether or not a particular message text is considered mitigating to emotional lows is subjective rather than objective in nature. We find it difficult to construe the metes and bounds of this subjective limitation given

³Additionally, while not necessary to our decision, we note that claims 25-37 do not explicitly state that the user understands the message being communicated.

the scant amount of guidance provided in Ceman's specification as to what is or is not considered mitigating to a women's emotional lows experienced during menstruation.

Ceman argues that its language of claim 38 is directed to a holistic treatment of a women's emotional condition. At the outset, we note that Ceman has failed to define what is considered to be a "holistic" treatment. Given the difficulty in construing the metes and bounds of Ceman's mitigating text language and the difficulty in determining what constitutes a "holistic" treatment of an emotional condition it is possible that Ceman's claim 38 message text is directed to a "holistic" treatment.

Ceman fails to provide a sufficient explanation of how a "holistic" treatment is functionally related to the claimed feminine care product. As recognized by Ceman, the feminine care product "treats the menstrual condition by collecting the discharge associated with discharge." (Appeal Brief, p. 10). This physical action of collecting discharge will function regardless of the presence of message text that mitigates a women's emotional condition. Using the approach taken in *Ngai*, the feminine product will achieve its desired result without the presence of the message text, even one that provides a "holistic" treatment. Hence, the feminine product does not depend upon the claimed text. Further, Ceman has failed to adequately explain, and we will not speculate, how the claimed text depends upon the feminine care product.

The Federal Circuits decision in *Gulack* makes it clear that "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." 703 F.2d at 1387, 217 USPQ2d at 405. As Ceman's printed matter is not functionally related to the substrate, a feminine care product, we affirm the examiner's rejection of Ceman '077 claims 25-52 over Beal '630 in view of Cole '698.

Specifically, the Ceman's '077 specification identifies Beal '630 as teaching a conventional feminine care product having the claimed absorbent body, adhesive coating, and covering. Further, to the extent that text of any sort is required for the covering, Cole '698 is relied upon for teaching well known and unremarkable proposition that one skilled in the art can place a text upon a consumer product for the purpose of creating a sufficiently attractive appearance and increase the desirability of the product.

We note that were we to adopt Ceman's position in this appeal, the mere placement of "have a nice day" text upon a known product transforms the known product into a new and unobvious product as it treats a person's emotional needs. Such a position is not consistent with *Gulack* or *Ngai*.

AFFIRMED

<i>Edward C. Kimlin</i>)
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